No. 15-866

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C.,

Petitioner,

v.

VARSITY BRANDS, INC, VARSITY SPIRIT CORPORATION, AND VARSITY SPIRIT FASHIONS & SUPPLIES, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF OF THE INTELLECTUAL PROPERTY LAW ASSOCIATION OF CHICAGO AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

SERENA PRUITT, *President*
THE INTELLECTUAL PROPERTY LAW ASSOCIATION OF CHICAGO
P.O. Box 472
Chicago, IL 60609

Of Counsel:
CHARLES W. SHIFLEY
BANNER & WITCOFF, LTD.
10 South Wacker Drive, Suite 3000
Chicago, IL 60606
(312) 463-5000

DAVID L. APPLEGATE*
WILLIAMS MONTGOMERY & JOHN LTD.
6100 Willis Tower
233 South Wacker Drive
Chicago, IL 60606
(312) 443-3200
dla@willmont.com

JEFFREY B. BURGAN
KEVIN PARKS
LEYDIG, VOIT & MAYER
Two Prudential Plaza
180 North Stetson
Chicago, IL 60601
(312) 616-5600

*Counsel of Record

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QUESTION PRESENTED

What is the appropriate test to determine when a feature of a useful article is protectable under section 101 of the Copyright Act?

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I. INTEREST OF *AMICUS CURIAE*[1]

Founded in 1884, the Intellectual Property Law Association of Chicago ("IPLAC") is the country's oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal locus and forum for the nation's authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association of over 1,000 members with interests in the areas of patents, trademarks, copyrights, and trade secrets, and the legal issues they present. Its members include attorneys in private and corporate practices before federal bars throughout the United States, as well as the U.S. Patent and Trademark Office and the U.S. Copyright Office. IPLAC represents both patent holders and other innovators in roughly equal measure. In litigation, IPLAC's members are split roughly equally between plaintiffs and defendants.[2] As part of its central objectives,

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[1] Pursuant to Supreme Court Rule 37.2, counsel of record received timely notice of the intent to file this brief under the Rule and consent was granted.

[2] In addition to the required statement of footnote 1, IPLAC adds that after reasonable investigation, IPLAC believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief,

IPLAC is dedicated to aiding in the development of intellectual property law, especially in the federal courts.[3]

II. SUMMARY OF ARGUMENT

IPLAC supports Petitioner's argument that the same standard test should determine when a feature of a useful article is protectable under section 101 of the Copyright Act. IPLAC takes no position on the merits of the case.

Under the Constitution, Congress may "secure for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST., Art. I, Sec. 8, Cl. 8. This delegated power's purpose is to "promote the Progress of Science [knowledge] and useful Arts." *Id.* Congress has exercised this power by creating a patent statute for inventors or discoverers of useful, novel, and non-obvious inventions or discoveries, 35 U.S.C. §§ 1 et seq.; a design patent statute for ornamental designs of useful objects, 35 U.S.C. §§ 171 et seq.; and a copyright statute for a host of original works fixed in a tangible medium of

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and (c) no one other than IPLAC, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

[3] Although over 30 federal judges are honorary members of IPLAC, none of them was consulted or participated in any way regarding this brief.

expression. 17 U.S.C. §§ 101 et seq. The current term of utility patents is generally twenty years from the date of application, 35 U.S.C. § 154; the current term of a design patent is fifteen years from the date of grant, 35 U.S.C. § 173; but the current term of a U.S. copyright may be 95 years or more. 17 U.S.C. §§ 302(c), 304(b); *see Eldred v. Ashcroft*, 537 U.S. 186, 199-204 (2003) (finding that Congress may constitutionally extend the term of existing copyrights, albeit not in perpetuity).

Given these different terms of protection, having a standard test for when section 101 of the Copyright Act may protect a feature of a useful article is essential to a coherent copyright scheme. Having a standard test is also essential to a coherent scheme for the protection of intellectual property more generally. Indeed, it is integral to the Congressional scheme for promoting "the Progress of Science and useful Arts." At bottom, that scheme must carefully balance the limited monopoly granted to the inventor or author with the benefit obtained by the public.

The inventor of a purely ornamental design for a cell phone screen, for example, should not be able to evade the Congressional fifteen-year limit of a design patent by claiming utility patent protection over that same ornamental design. If some aspect of the cell phone screen somehow constitutes a novel, useful, and non-obvious invention or discovery, then the inventor may apply for a utility patent, but the claimed invention must also meet the other statutory requirements for obtaining a patent. *See* 35 U.S.C. §§ 101 et seq.

Likewise, the ornamental design on that same cell phone screen may be subject to copyright protection, so long as it qualifies as an "original work of authorship" and meets the other statutory requirements for copyrightability. *See* 17 U.S.C. §§ 101 et seq. However, copyright protection does not extend to the functional aspects of the cell phone screen itself. *Id.*; *see also, Mazer* v. *Stein*, 347 U.S. 201 (1954); 35 U.S.C. §§ 101 et seq.

Thus, the creator of a useful article should not be able to circumvent the temporal limit on a utility patent by instead claiming copyright protection for its "design." Rather, that creator must look for some other form of protection, such as trade secret, or subject itself to the normal competitive forces of the marketplace for its products.

Consonant with the Constitution, the Congressional statutory scheme also reflects a balance between state and federal protections. A trademark owner may choose, for example, either common law trademark protection or federal registration. Depending on the nature of the invention or discovery, one may choose between federal patent protection on the one hand and either federal or state law trade secret protection on the other.[4]

For the statutory scheme to work properly in each of these examples, the courts must apply a consistent test for affording the statutory protection. IPLAC therefore supports Petitioner in arguing for a common test of uniform application but argues in

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[4] The Defend Trade Secrets Act of 2016 creates a federal civil cause of action for trade secret misappropriation.

favor of neither party on the merits. Instead, IPLAC submits that the so-called "side-by-side" analysis for conceptual separability set forth in the COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES III, § 924.2(B) (2014) is the appropriate test for determining when a feature of a useful article is protectable under Section 101 of the Copyright Act.

III. ARGUMENT

A. The People of the United States Have Both Practical and Constitutional Interests in Consistent Federal Protection of the Creations and Discoveries of Authors and Inventors.

The purpose of the Constitution's patent and copyright clause is "to promote the Progress of Science and the Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST., Art I, Sec, 8, Cl. 8. Those rights, limited in time, are in turn ancillary to the purposes of the Constitution itself: "to form a more perfect Union, establish Justice, insure domestic Tranquility, provide for the common Defence, promote the general Welfare, and secure the Blessings of Liberty to ourselves and our Posterity ... " *Id.*, Preamble.

Against that background, the Congressional representatives of the people and the States have established over time comprehensive schemes for protecting and limiting intellectual property rights. These legislative schemes currently comprise federal laws governing both utility and design patents, 35 U.S.C. §§ 1 et seq.; trademarks and trade dress, 15 U.S.C. §§ 1051, et seq.; copyrights, 17 U.S.C. §§ 101

et seq.; plant varieties, mask works, and unfair competition, e.g., 19 U.S.C. §§ 1337, et seq.; and, most recently, trade secrets, 18 U.S.C. § 1836 (b). Nowhere among them is the protection of clothing designs per se. *See., e.g., Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 455 (2d Cir. 1989) (clothes cannot be copyrighted); Registrability of Costume Designs, 56 Fed. Reg. 56,530 at 56,531 (Nov. 5, 1991) ("Garments are useful articles, and the designs of such garments are generally outside of the copyright law.").

The effect of these statutes and regulations is both inclusionary and exclusionary. The inventor who successfully commercializes an invention enjoys either profits or a licensing revenue stream, but can exclude others for only a limited time. Thereafter the public is free to exploit the invention and to improve upon it. The author of a successful play or novel – and his or her descendants – will enjoy royalties from performances or book sales and the right to create derivative works, but only until the copyright expires. Then others may exploit and build upon those works, which become part of the public domain. *See, e.g., Eldred*, 537 U.S. at 214-215.

Trademarks and trade dress can distinguish products and services so long as they are used consistently in commerce. Registered marks may enjoy the benefits of registration so long as they are used in commerce and a fee is paid. *See, e.g.*, 15 U.S.C. § 1059(a). Trade secrets can last forever, so long as they remain subject to reasonable efforts to maintain their secrecy and derive independent financial value from it. *See, e.g., Peabody v. Norfolk*, 98 Mass. 452 (1868).

But each of these statutory rights also has costs and limitations. The Congressional cost-benefit analysis is upset when the statutory scheme intended for one kind of innovation is applied to another kind of innovation. Only by knowing which is which and applying the correct protection is the statutory scheme preserved. And only then is the proper balance struck between the rights of innovators and the rights of the public.

If one could obtain a utility patent for an ornamental design, for example, one could double the intended period of protection. If one could copyright a patentable invention, one could extend the patent monopoly by at least half a century. At least according to legislative judgment, that would over-compensate innovators and overly restrict the rights of the consuming public.

B. A Multiplicity of Tests Unfairly Confounds the Rule of Law for Both Innovators and the General Public.

A nation of laws and not of individuals needs laws that are user-friendly: readily ascertainable, consistent, and easy to apply. Anything else leaves the legal process solely in the hands of experts and subjects the rule of law itself to disdain. For an innovator to obtain one result in one jurisdiction and, on the same facts, a different result in another, is inherently antithetical to the rule of law. It creates confusion among innovators, suggests arbitrariness to the general public, breeds disrespect for the rule of law, and invites forum-shopping by litigants.

This is particularly true in the case of federal law, such as the copyright law at issue here. Subject only to Constitutional constraints, state laws may of

course vary, for the states are the laboratories of democracy. *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting). But federal law should not vary from district to district or circuit to circuit. As Petitioner points out, however, that is essentially the case before the Court. Pet. Br. at 20, citing Pet. App. 30a-33a.

To be copyrightable, the "pictorial, graphic, or sculptural" features of a "useful article" must be capable of being "identified separately from, and ... capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101. Yet as Petitioner discerns from the case law and academic writing, ten or eleven different tests for "conceptual separability" currently exist:

1. **The Copyright Office Approach**: "... only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES III § 924.2(B) (2014). Cert. Pet. at 21.

2. **The Primary–Subsidiary Approach**: if the artistic features of the design are "primary" to the subsidiary utilitarian function. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980). *See* Pet. Br. at 42.

3. **The Objectively Necessary Approach**: if the artistic features of the design are "wholly unnecessary to the performance of the utilitarian function" of the article. *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 419 (2d Cir.1985). *See* Pet. Br. at 42.

4. **The "Ordinary–Observer" Approach**: if "the design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously." *Id.* at 422 (Newman, J., dissenting). *See* Pet. Br. at 42.

5. **The Design–Process Approach**: if the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987); *see, also, Pivot Point Int'l, Inc.* v *Charlene Prods., Inc.*, 372 F.3d 913, 930-931 (7th Cir. 2004); Robert C. Denicola, *Applied Art & Indus. Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV 707, 741–45 (1983). *See* Pet Br. at 40.

6. **The Stand–Alone Approach**: if "the useful article's functionality remain[s] intact once the copyrightable material is separated." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting). *See* Pet. Br. at 42.

7. **The Likelihood–of–Marketability Approach**: if "'there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.'" *Galiano v. Harrah's Operating Co., Inc.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 M. NIMMER and D. NIMMER, NIMMER ON COPYRIGHT § 2.08[B][3], at 2-101); *see, also, Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 330 (2d Cir. 2005) (applying something like the ordinary-observer approach). *See* Pet. Br. at 35.

Two academic approaches that have not been adopted by any federal appellate courts:

8. **The William Patry approach** ("whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article.") *See* 2 W. PATRY, PATRY ON COPYRIGHT §§ 3.145–46. *See* Pet. Br. at 43.

9. **The subjective-objective approach** (citing Note, Barton R. Keyes, Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law, 69 OHIO ST. L.J. 109, 141 (2008)). *See* Pet. Br. at 43; Pet. App. 33a.

10. **The Sixth Circuit Panel Majority Approach**:

(1) Is the design a pictorial, graphic, or sculptural work?

(2) If [so], is it a design of a useful article?

(3) What are the utilitarian aspects of the useful article?

(4) Can the viewer of the design identify "pictorial, graphic, or sculptural features" "separately from the utilitarian aspects of the [useful] article[?]"

(5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "exist[] independently of [] the utilitarian aspects of the [useful] article[?]"

[Pet. App. 37a–39a (quoting 17 U.S.C. § 101) (alterations within quotations done by panel majority).]

11. **The Seventh Circuit/Goldstein approach**: "the artistic features 'can stand alone as a work of art traditionally conceived, and . the useful article in which it is embodied would be equally useful

without it.'" *Pivot Point*, 372 F.3d at 923 (quoting 1 Paul Goldstein, Copyright: Principles, Law & Practice § 2.5.3, at 109 (1989)) (alteration in original). Cert. Pet. at 23, n. 8.

Many of these tests are similar and overlap. The "stand–alone approach," for example (if "the useful article's functionality remain[s] intact once the copyrightable material is separated") is hard to distinguish from the Copyright Office approach ("if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article").

Likewise, the "likelihood–of–marketability" approach ("even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities") is substantially similar to the "ordinary-observer" approach. *See Chosun Int'l, Inc.*, 413 F.3d 324 at 330 (manufacturer of children's plush animal Halloween costumes may be able to show that they invoke in prospective customers a concept separate from that of the costume's "clothing" function). The Sixth Circuit panel majority's five-step approach, in turn, can be viewed as an algorithm for applying a combination of the "ordinary observer" test (step 4) and the "stand–alone" approach (step 5) or, as argued below, essentially an application of the Copyright Office test.

All of this makes wonderful fodder for law review articles and judicial opinions, but none of it does anything to promote the "just, speedy, and inexpensive determination of every action and proceeding." Fed. R. Civ. P. 1. Nor does it do

anything to advance the interests of innovation in the economy or to promote respect for the rule of law.

In *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), this Court resolved a conflict among the circuits in discerning a common test for federal trade dress rights. In particular, it did so in the context of a dispute in which "the functional aspect of the design" was at the core. *Id.* at 26-27 The present case demonstrates more confusion than conflict, but cries out equally for a common test.

C. The Court Should Adopt the Copyright Office Side-by-Side Approach as the Common Test Nationwide.

For the following three reasons, IPLAC urges adoption of the Copyright Office test for conceptual separability set forth in the COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES III, § 924.2 (2014) as the appropriate test for determining when a feature of a useful article is protectable under Section 101 of the Copyright Act.

First, the Copyright Office test already reflects agreement within the legislative branch of government and between the legislative and judicial branches. It is consistent with the statute and its legislative history, and it conforms to this Court's *Mazer v. Stein* decision, which introduced to copyright the concept of separability. 347 U.S. 201, 205 (1954). Second, the Copyright Office test reflects the acknowledged authority on copyright, namely the Register of Copyrights. It is the Register's office that is charged with administering and applying the statute on a day-to-day basis and that developed the Compendium. Third, as the Sixth Circuit's decision

below demonstrates, the Copyright Office test is both practical and administrable.

1. The Copyright Office Test Reflects the Judgment of the Legislative and the Judicial Branches of Government.

The Copyright Office test is consistent with both the Copyright Act and with precedent. It therefore already reflects the judgment of the legislative and the judicial branches of government.

Section 101 of the Copyright Act defines both "pictorial, graphic, and sculptural works" and "useful articles." 17 U.S.C. § 101. It further provides that the design of a useful article shall be considered a "pictorial, graphic, or sculptural work" only if, and to the extent that, such design incorporates "features that can be identified separately from, and are capable of existing independently of" the utilitarian aspects of the article. *Id.*

The Copyright Office test reflects this statutory distinction perfectly.

Compendium § 924.2(B) defines "conceptual separability" as meaning that "a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be *physically* separated from the article by ordinary means" (emphasis added). The key instead is visual or imaginative separation: that is, the ability to exist side by side as fully realized, separate works, one artistic and one useful.

Section 924.2(B) describes this key as follows:

> This artistic feature must be capable of being visualized – either on paper or as a

> free-standing sculpture – as a work of authorship that is independent from the overall shape of the useful article.
>
> In other words, the feature must be imagined separately and independently from the useful article without destroying the basic shape of that article.
>
> A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article.

Compendium, § 924.2(B) (sub-paragraphing added).

This consistency of language is no accident. The Copyright Office test and the language of the current Act trace their roots to this Court's 1954 *Mazer* decision, in which the Court upheld the plaintiff's copyrights in dancing figurines that formed the base for table lamps. In holding the statuettes copyrightable, the Court found guidance in Copyright Office practices and then-current (1949) regulations providing for registration of "works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned ... " 347 U.S. at 211-214.

As Petitioner points out, the Copyright Office issued a 1959 regulation to accommodate the Court's holding in *Mazer*. Accordingly, design features "which can be identified separately and are capable of existing independently as a work of art ... will be eligible for registration." Pet. Brief on Cert, p. 9, citing 37 C.F.R. § 202.10(c) (1959) (revoked after implementation of the 1976 Copyright Act). Thus,

Mazer introduced the notion of conceptual separability; the Copyright Office regulations immediately followed; and the statute itself, as quoted above, now incorporates the same language. 17 U.S.C. § 101. The Copyright Office test and Section 101 have "grown up" together, organically and interdependently, in the wake of *Mazer*. No other conceptual separability test can boast this lineage.

2. The Compendium is The Recognized Authority on Conceptual Separability.

As this Court has recognized, "to the extent that [such] interpretations have 'the power to persuade'," courts may consider interpretations set forth in administrative manuals and policy statements. *Christensen v. Harris County*, 529 U.S. 576, 587 (2000) (internal citations omitted).

The Compendium is the Register of Copyrights' administrative manual concerning the Copyright Act and related federal regulations. As such, it "provides expert guidance to copyright applicants, practitioners, scholars, the courts, and members of the general public regarding institutional practices and related principles of law" Compendium, Intr., p. 1. Released recently on December 22, 2014, the Third Edition reflects not only the legal expertise of those within the Copyright Office, but also contributions from practitioners and the broader copyright community. Compendium, Acknowledgements.

Although these policies and practices do not have the force of law. they do explain the legal rationale for determinations by the Copyright Office. Compendium, Intr., p. 2. This is particularly important in circumstances, such as those here, that

lack controlling judicial authority. Accordingly, courts have cited the Compendium in numerous copyright cases over the years, including on the question of conceptual separability. In *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038 (9th Cir. 2014), for example, the Ninth Circuit found the Compendium (Second Edition) "persuasive" on conceptual separability. *Id.* at 1041-42. It therefore affirmed the district court's conclusion that the shape of a hookah water container was not copyrightable. *Id. See also, Alaska Stock, LLC v. Houghton Mifflin Harcourt Pub. Co.*, 747 F.3d 673, 684-85 (9th Cir. 2014) (Compendium "persuasive" on database registration requirements); *Metro. Regl. Info. Sys., Inc., v. Am. Home Realty Network, Inc.*, 888 F. Supp. 2d 691, 706-07 (D. Md. 2012) (deferring to Compendium on registration requirements for collective works); *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F Supp. 2d 722,732 (S.D. Tex. 2012) (Copyright Office policies and manuals entitled to deference given the specialized experience of the agency); *McLaren v. Chico's FAS, Inc.*, 2010 U.S. Dist. LEXIS 120185, at **9-10 (S.D.N.Y Nov. 9, 2010) (Office's interpretation of the unit of publication regulation "is particularly compelling").

The Court should recognize the Copyright Office test as persuasive by adopting it here and for the future.

3. The Copyright Office Test is Both Administrable and Practical.

As this Court emphasized recently in choosing the appropriate standard for awarding fees to prevailing parties under Copyright Act § 505, the Court may wish to adopt the "more administrable" of

alternative approaches. *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979 (2016). As Justice Kagan reasoned in adopting the "objective reasonableness" standard, "[a] district court that has ruled on the merits of a copyright case can easily assess whether the losing party advanced an unreasonable claim or defense." *Id.* at 1987.

A similar case can be made for the Copyright Office test here. Copyright Office personnel have used the test for decades to evaluate copyright applications, even without the benefit of evidence extrinsic to the application itself. Courts are equally capable of determining whether a design feature can be "identified" separately and "exist" independently of a useful article. In a given case, evidence extrinsic to the application itself may aid in the court's determination. Yet in contrast to tests that might *require* extrinsic facts for their application (the design-process and likelihood-of-marketability approaches, for example), courts can apply the Copyright Office test regardless of the scope of the trial court record. In the "least evidence" scenario, courts would simply apply the test in the same manner as the Copyright Office—on the basis of the application and deposit material alone.

Finally, the Sixth Circuit's opinion below demonstrates the practicality of the Copyright Office test. After surveying the panoply of tests used by courts and suggested by scholars, the Sixth Circuit determined first that that Varsity's designs qualified as "graphic works" and constituted "useful articles" with "an intrinsic utilitarian function"—namely to "cover the body, wick away moisture, and withstand the rigors of athletic movements." Pet. App. 43a. It then found that it could "identify" graphic features of

Varsity's designs—the arrangement of stripes, chevrons, zigzags, and color blocking— "separately from" the utilitarian aspects of the uniforms. Pet. App. 45a. In doing so, the Sixth Circuit emphasized that Varsity's graphic designs did not enhance the uniforms' functionality as clothing. In particular, it noted that "[a] plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip." Pet. App. 45a.

Consistent with this analysis, the court below found that "a graphic design and a blank cheerleading uniform can appear 'side by side'—one as a graphic design, and one as a cheerleading uniform." Pet. App. 46a. In doing so, the court cited specifically to the Copyright Office test set forth in Compendium III § 924.2(B). *Id.* To complete its analysis, the Sixth Circuit then asked whether Varsity's designs "exist independently of the utilitarian aspects of a cheerleading uniform," again invoking the Copyright Office test. "We believe they can," the court concluded, noting in part that it could envision Varsity "printing or painting its designs, framing them, and hanging the resulting prints on the wall as art." Pet. App. 46-47a.

In sum, consonant with *Kirtsaeng v. John Wiley & Sons, Inc.*, the Sixth Circuit's substantive analysis below demonstrates the administrability and practicality of the Copyright Office test for conceptual separability. On remand, of course, even assuming Varsity's designs are found protectable and original (a question not before the Court of Appeals), the scope of its copyrights may be so "thin" that Star Athletica does not infringe them.

IV. CONCLUSION

For all these reasons, IPLAC urges the Court to adopt the Copyright Office side-by-side approach as the appropriate nationwide test for determining when a feature of a useful article is protectable under section 101 of the Copyright Act. IPLAC takes no position concerning the merits of the action.

Respectfully submitted,

SERENA PRUITT, PRESIDENT
THE INTELLECTUAL PROPERTY
LAW ASSOCIATION OF CHICAGO
P.O. Box 472
Chicago, IL 60609

DAVID L. APPLEGATE*
WILLIAMS MONTGOMERY &
JOHN LTD.
6100 WILLIS TOWER
233 SOUTH WACKER DRIVE
CHICAGO, IL 60606
(312) 443-3200

OF COUNSEL:
CHARLES W. SHIFLEY
BANNER & WITCOFF, LTD.
10 SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606
(312) 463-5000

JEFFREY B. BURGAN
KEVIN PARKS
LEYDIG, VOIT & MAYER
TWO PRUDENTIAL PLAZA
180 NORTH STETSON
CHICAGO, IL 60601-6731
(312) 616-5600

Counsel for Amicus Curiae

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*Counsel of Record